

REMARKSA. Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the Declaration of Ms. Rieko Takahashi, the Terminal Disclaimer and following remarks.

B. The Invention

The present invention is directed to a printing method and a lithographic printing plate exhibiting superior exposure visibility and enhanced sensitivity without producing stains.

In one of the novel aspects of the invention, the printing plate is composed of a flexible support having a hydrophilic layer and an image forming layer, wherein the flexible support with the hydrophilic layer exhibits a transmission density of 0.5-1.2 and the unexposed areas of the image forming layer exhibit a glossiness of 0.1-10.

C. Claim Status and Amendments

Claims 1-20 are presented for further prosecution. No claim amendments have been made at this time.

D. The Office Action

Claims 1-20 had been rejected as indefinite under § 112, second paragraph. Claims 1-20 had been rejected as being anticipated by Inoue (EP 1145848). Claims 1, 7 and 9 had been provisionally rejected for obviousness-type double patenting as being unpatentable over claims 1, 6 and 8-12 of US Application No. 10/943,935.

1. The rejection under § 112, second paragraph

Claims 1-20 had been rejected as indefinite as failing to particularly point out and distinctly claim the invention. Applicants disagree with the rejection.

A rejection under the second paragraph of § 112 is made when the claims are unclear. It is submitted that claim 1 is clear because the scope of claim 1 can be accurately determined. For example, claim 1 recites a lithographic printing plate including a flexible support, a hydrophilic layer and an image forming layer. The composition of the printing plate is therefore accurately specified. Also, claim 1 recites that the transmission density is 0.5-1.2 and the glossiness is 0.1-10. These properties are also accurately specified.

Applicants therefore respectfully submit that claims 1-20 comply with the requirements of § 112, second paragraph.

2. Inoue does not inherently teach the claimed transmission density

The Examiner had recognized that Inoue does not specifically teach the claimed transmission density or the claimed glossiness. However, the Examiner had taken the position that Inoue inherently exhibits the claimed properties because Inoue discloses the composition of the printing plate of the present invention (section 7 of the Office Action). Applicants disagree.

Applicants had previously explained that the claimed transmission density and the claimed glossiness are satisfied by considering the composition of the support, hydrophilic layer and image forming layer (see Declaration of September 21, 2005). Inoue does not teach or suggest that the compositions of these layers must be considered with regard to the transmission density and the glossiness. As a result, Inoue does not inherently teach the claimed transmission density. It is noted that when a reference is silent concerning a claimed limitation, the reference must always satisfy the claimed limitation to maintain an inherency rejection. As explained in MPEP § 2112(IV), the fact that a certain property may be present in the prior art is not sufficient to establish inherency. The missing teaching must be necessarily present in the reference.

Applicants submit that Inoue does not inherently teach the present invention because the claimed transmission density is not necessarily present in Inoue. As proof, Applicants have enclosed a Declaration of Ms. Takahashi. Although the Declaration is currently unexecuted, consideration of the Declaration is requested since the information contained therein originated with Ms. Takahashi and is therefore entirely reliable.

Ms. Takahashi prepared Sample 5 in Table 2 of Inoue which is described beginning in par. 179. Sample 5 employed an aluminum substrate as described in par. 183 of Inoue.

Ms. Takahashi subjected Sample 5 to densitometry to determine the transmission density. As reported in par. 4 of the Declaration, the transmission density could not be determined because the aluminum substrate did not transmit light. The transmission density therefore approached infinity, which is outside the claimed range of 0.5-1.2.

Applicants submit that Ms. Takahashi has demonstrated that the examples of Inoue do not always teach the claimed transmission density because Sample 5 of Inoue is outside the claimed range. Inoue therefore does not necessarily teach the invention as required to maintain an inherency rejection (MPEP § 2112(IV)). Applicants respectfully submit that the present invention is not anticipated by Inoue.

3. Inoue does not inherently teach the claimed transmission density, even if a plastic substrate is employed

Inoue teaches a plastic substrate in par. 108. However, even if the plastic substrate is employed, Inoue does not inherently teach the claimed transmission density.

A printing plate having a plastic support does not necessarily satisfy the claimed transmission density. For example, Table 6A of the September 2005 Declaration of Ms. Rieko Takahashi demonstrated that sample 002 having a PET substrate (page 40 of application) had a transmission density of 0.33, while sample 003 having a blue-tinted PET substrate (page 42 of application) had a transmission density of 0.55. Thus, PET substrates do not necessarily always produce the same transmission density.

Applicants therefore respectfully submit that the plastic substrate does not inherently satisfy the claimed transmission density. As demonstrated by Ms. Takahashi, PET substrates do not necessarily produce the same transmission density. Thus, in accordance with MPEP § 2112(IV), Inoue does not necessarily teach the claimed transmission density as required to maintain an inherency rejection.

4. The double patenting rejection

Applicants have enclosed a Terminal Disclaimer to overcome the provisional double patenting rejection. PTO 2038 is enclosed for the fee.

E. Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

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Encl: Declaration of Ms. Rieko Takahashi
Terminal Disclaimer with PTO 2038
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